

## REMARKS

This Amendment and Request for Reconsideration is filed in response to the Office Action mailed on 31 August 2006 for the subject patent application.

In the present Amendment, the Applicants amend claims 1-7, 11-15, 17-18, 22-27, 29-30, and 35, and add new claims 36-39; no claims have been canceled. The Applicants respectfully submit that no new matter has been added by this Amendment; the subject matter claimed is fully supported in the present application as originally filed. The Applicants respectfully request entry of this Amendment and reconsideration of the claims as amended.

*In the Office Action mailed on 31 August 2006 for the subject patent application, the Examiner rejected claims of the application under 35 U.S.C. § 102 and 103 based on Feder et al. (U.S. Patent Application Publication 2004/0142693), Einola et al. (International Publication WO 01/22764 A1), and Pecan et al. (U.S. Patent Application Publication 2004/0097233). In response, the Applicants respectfully disagree with the rejection of claims and submit that all claims as amended are allowable over the prior art of record for at least the following reasons.*

For proper rejection of claims under 35 U.S.C. §§ 102 and 103, the prior art in combination must teach or suggest each and every limitation of the claims. In addition, there must be some adequate suggestion or motivation to combine the teachings of the prior art.

Regarding Claims 1-6, 11-17, and 23-29. The prior art in combination fails to teach or suggest each and every step recited in the claims. In particular, with respect to claims 1-6, 11-17, and 23-29, the prior art in combination fails to teach or suggest the steps of "identifying, at the mobile station, that a first base station transceiver system identified from the scanning provides a Third Generation (3G) or greater communication

service” and “identifying, at the mobile station, that a second base station transceiver system identified from the scanning fails to provide the 3G or greater communication service but provides a communication service that is less than the 3G or greater communication service” such as “a Second Generation (2G) communication service,” and then subsequently cause “the first base station transceiver system to be selected for communication over the second base station transceiver system based at least in part on identifying that the first base station transceiver system provides the 3G or greater communication service and the second base station transceiver system fails to provide the 3G or greater communication service.”

The Feder et al. reference is directed specifically to network selection between heterogeneous wireless networks – specifically, between Third Generation (3G), 802.11 Wireless Local Area Network (WLAN), and Wireless Personal Area Network (PAN) systems. At the time of Feder et al., standards for selecting between heterogeneous wireless networks were not well-defined. This void left some opportunity to devise new selection techniques based on various preferences and desires of the user, some of which are described in the Feder et al. reference. The Feder et al. reference is also specifically concerned with a wireless system that provides a Third Generation (3G) communication service — not to any wireless system that provides a communication service that is less than a 3G communication service such as a Second Generation (2G) communication service.

On the other hand, standards for network selection in homogeneous networks of the wireless wide area network (WWAN) type (e.g. which may be referred to as cellular telecommunication networks) have already been well-defined and documented in standard specifications. This environment is the background and context of the present invention as defined in claims 1-6, 11-17, and 23-29. As is well-known, conventional techniques for handing-off between base station cells of WWANs have been based on signal strength. For example, see paragraph 45 on page 5 of the present application as published:

...the mobile station will consider conventional handoff techniques (step 338 through a connector A1). When conventional handoff techniques are considered at step 338, the mobile station facilitates a handoff to the candidate system if its signal quality is stronger than the signal quality of the current system. Conversely, if the signal quality of the candidate system is not better than that of the current system, then a handoff to the candidate system is not initiated and communication is maintained with the current system. In the present embodiment, the signal quality of the candidate system is better or greater than that of the current system if the candidate's system is at least 2 dB greater than that of the current system.

Despite such standards, the present invention employs techniques that are otherwise contrary to these methods. The present invention may be distinguished from conventional handoff techniques for WWANs in that it “[i]dentifies], at the mobile station, that a first base station transceiver system identified from the scanning provides a Third Generation (3G) or greater communication service” and “[i]dentifies], at the mobile station, that a second base station transceiver system identified from the scanning fails to provide the 3G or greater communication service but provides a communication service that is” e.g. “a Second Generation (2G) communication service,” and then subsequently causes “the first base station transceiver system to be selected for communication over the second base station transceiver system based at least in part on identifying that the first base station transceiver system provides the 3G or greater communication service and the second base station transceiver system fails to provide the 3G or greater communication service” ... “even if the signal quality [of the first base station transceiver system] is less than that of the second base station transceiver system.”

Again, the Feder et al. reference is directed specifically to selection between heterogeneous systems – Third Generation (3G), 802.11 Wireless Local Area Network (WLAN), and Wireless Personal Area Network (PAN) systems. As stated in the Feder et al. reference in paragraph 19: “[t]he systems detected by the mobile station may include systems of a type, which is different than, and disparate (i.e., not compatible) with respect to, the system current serving the mobile station.” In any case, the Feder et al. reference does not address a wireless system that provides a communication service that is less than

a 3G communication service such as a Second Generation (2G) communication service. The Feder et al. reference is not directed to selection or handoffs between WWAN networks which provide either 2G or 3G communication services as is the present application. The teachings of the Feder et al. reference are primarily directed to “a method for a mobile client to choose amongst wireless and wireline service providers” as stated in the background of the invention in paragraph 1 of the reference.

Further, there would be no adequate suggestion or motivation to modify the Feder et al. reference to obtain the techniques of the present invention. The Einola reference, used in combination with the Feder et al. reference, teaches network-based (not mobile-based) selection techniques between wireless networks. In the Feder et al. reference, the mobile station makes decisions regarding the selection of systems. These are two separate and distinct approaches. Also again, the Feder et al. reference is not concerned with selection or handoffs between WWAN networks which provide either 2G or 3G communication services.

Based on the above, the Applicants respectfully request the Examiner to withdraw all rejections for claims 1-6, 11-17, and 23-29 as amended.

Regarding Claims 7-10, 18-22, and 30-35 The prior art in combination fails to teach or suggest each and every step recited for other claims as well. In particular, with respect to claims 7-10, 18-22, and 30-35, the prior art in combination fails to teach or suggest the steps of “identifying, at the mobile station, that at least a first base station transceiver system identified from the scanning provides a predetermined digital communication service for the mobile station” and “identifying, at the mobile station, that at least a second base station transceiver system identified from the scanning fails to provide the predetermined digital communication service for the mobile station” so that the mobile station can “[produce] and [send] a list of handoff candidate identifiers to a serving base station transceiver system which includes a first identifier for the first base station transceiver system but excludes a second identifier for the second base station

transceiver system based on identifying that it fails to provide the predetermined digital communication service.”

The Einola reference does indeed teach a CLASSMARK message which includes information useful to the neighboring UMTS networks. However, the Einola reference does not teach or suggest that such message includes a first identifier for the first base station transceiver system but excludes a second identifier for the second base station transceiver system based on identifying that it fails to provide the predetermined digital communication service. Neither does the Feder et al. reference. The Einola reference utilizes network selection techniques which are based on network-employed techniques which require changes to the network. Advantageously, according to the present invention as defined by claims 7-10, 18-22, and 30-35, the mobile station is adapted to provide such unique control and selection without any significant changes required in the networks.

Based on the above, the Applicants respectfully request the Examiner to withdraw all pending rejections for claims 7-10, 18-22, and 30-35.

Finally, the Applicants have noted a few missing portions of flowchart arrows in the FIGs. 1-3, and have provided corrected drawings to replace the same. No new matter has been added by replacing these figures, which merely clarify and conform the drawings to that which was already clearly described in the originally-filed patent application.

Based on the above, all claims as amended are allowable over the prior art of record and the application is now in a condition suitable for allowance. The Applicants respectfully request entry of the Amendment, reconsideration of the claims as amended in light of the above arguments, and allowance of the application at the earliest opportunity.

Thank you. The Examiner is invited to contact the undersigned if necessary to expedite prosecution of the present application.

Respectfully Submitted,

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